



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,511	01/29/2004	Carl Arnold Koppel	SES-001-US	5963

7590 12/05/2008
PATRICK REILLY
BOX 7218
SANTA CRUZ, CA 95061-7218

EXAMINER

CAO, PHUONG THAO

ART UNIT	PAPER NUMBER
----------	--------------

2164

MAIL DATE	DELIVERY MODE
-----------	---------------

12/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/767,511		KOPPEL ET AL.	
	Examiner		Art Unit	
	Phuong-Thao Cao		2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Amendment filed on 06/23/2008.
 2. Claims 5, 6, 8 and 9 have been amended, and claim 10 was previously cancelled.
- Currently, claims 1-9 are pending.

Specification

3. The disclosure is objected to because of the following informalities:

Regarding the section "Related Patent Applications", on page 2, the U.S. Provisional Patent Ser. No. 60/510,792 is filed on October 11, 2003 instead of October 10, 2003 as disclosed.

Regarding paragraph "Certain yet alternate preferred embodiments of the method of the present invention may include a plurality of user-defined files, or plurality of "UDF's", each UDF associated with a record stored in a table, and *each UDF*", on page 7, the disclosure is unclear about the "each UDF" disclosed at the end.

Regarding line 5 of paragraph "These items are created...", on page 10, the disclosed "Accreting and storing" is believed to be "Creating and storing".

Appropriate correction is required.

Response to Amendment

4. Amendments to claims 5, 6, 8 and 9 are effective to overcome the 112, 2nd paragraph rejection in the previous office action. Therefore, the previous 112 rejection has been withdrawn.

Response to Arguments

5. Applicant's arguments filed 06/23/2008 have been fully considered but they are not persuasive.

Since the rejection of the claimed invention is based on a broad and reasonable interpretation of its claim language, arguments based on characteristics/functionalities that are not specifically claimed to distinguish the claimed invention from the prior art are considered as invalid.

To allow Examiner to respond properly to the arguments regarding the prior art rejection, Applicant should specify which limitation/step is not taught or suggested by the prior art. Applicant did not address any argument regarding to the rejection mailed on 12/10/2007.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-9 (effective date 7/24/2001) are rejected under 35 U.S.C. 102(e) as being anticipated by Fish (US Publication No 2003/0220891, effective filing date 12/22/2000).

As to claim 1, Fish teaches:

“In a computer, a method for adding additional information into a data field of an existing software record associated with a software table” (see Fish, [0010]-[0011] and [0100]-[0102]), the method comprising:

“forming a first user-defined data field structure, or first “UDF”” (see Fish, [0015] and [0101]-[0102] for adding user-defined fields to matter record wherein each row in table (Fig. 13b) defining an identifier and a value of a user-defined field associated with a matter number is interpreted as user-defined data field structure), the first UDF comprising:

“a record identifier datafield” (see Fish, [0097], [0102] and Fig. 13a-b wherein field 1380 storing matter number is interpreted as a record identifier datafield),

“a UDF identifier datafield” (see Fish, [0102] and Fig. 13b wherein field 1381 storing identifier of a user-defined field is interpreted as a UDF identifier datafield), and

“a first datafield” (see Fish, [0102] and Fig. 13b wherein field 1382 storing value corresponding to the user-defined field is interpreted as a first datafield);

“storing a record identifier in the record identifier datafield” (see Fish, [0097] [0102] and Fig. 13b wherein matter number is interpreted as a record identifier);

“storing a UDF identifier in the UDF identifier datafield” (see Fish, [0100]-[0104] and Fig. 13b); and

“storing an additional information in the first datafield, whereby the first data field is associated with the record and the additional information stored in the first data field is associated with the record and without modification of the table” (see Fish, [0096]-[0102] and Fig. 13a-b wherein corresponding value is interpreted as additional information stored in field 1382 (first datafield) which is associated with a matter record referenced by matter number; also see [0076] and [0079]).

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a classification of data type, the classification of data type distinguishing the data type of the additional information stored in the first datafield” (see Fish, [0103]); and

“associated the metadata with the first UDF” (see Fish, [0051]-[0053]).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a name, the name associated with the first UDF and the name for use in software operations accessing the first UDF” (see Fish, [0052]-[0053] wherein identifier is interpreted as a name as recited; also see [0087]); and

“associated the metadata with the first UDF” (see Fish, [0102] and [0052] wherein each user-defined field is associated with an identifier (metadata)).

As to claim 4, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a title, the title associated with the first UDF and a name for use in a visual display of additional information of the first UDF” (see Fish, Fig. 7); and

“associated the metadata with the first UDF” (see Fish, [0015] wherein field description associated with each user-defined field can be interpreted as title as claimed).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a class plurality of UDF’s and wherein the first datafield comprises a class identifier of the class plurality of UDF’s, and each UDF of the class plurality includes: the class identifier; a unique identifier of the UDF of the class plurality of UDF” (see Fish, [0017] wherein a class plurality of UDF’s includes milestones, office procedures, matter details, etc); and

“datafield, whereby each datafield of the class plurality of UDF's is associated with the first UDF and therefrom associated with the record, and information is stored in the plurality of datafield of the class plurality of UDF, and associated with the first UDF, and therefrom the information of the plurality of datafields of the class plurality of UDF's is associated with the record and without modification of the table” (see Fish, [0085] for associating number of addresses (the class plurality of UDF’s) with a given contact (first UDF)).

As to claim 6, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a plurality of UDF’s” (see Fish, [0097], [0107] and Fig. 13a-b);

“storing an identifier of the first UDF in the record identifier datafield of each of the plurality of UDF's" (see Fish, Fig. 13b wherein matter number is interpreted as identifier of the first UDF);

“storing a unique UDF identifier in the record identifier datafield of each of the plurality of UDF’s” (see Fish, Fig. 13b);

“storing information in each of the first datafields of each of the plurality of UDF’s, whereby the plurality of first datafields of the plurality of UDF’s are associated with the first

Art Unit: 2164

UDF and information is stored in the plurality of datafields and associated with the first UDF, and therefrom the information of the plurality of datafields is associated with the record and without modification of the table” (see Fish, Fig. 13 a-b for associating of values (information in the plurality of datafields) with a matter number (first UDF) which represent a matter record [0097]; also see [0085] and [0101] for associating number of addresses with a given contact wherein each identifier/value pair represents an user-defined field).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“storing a pointer in the record identifier datafield for use as the record identifier” (see Fish, [0101] for storing a pointer to an identifier).

As to claim 8, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“each UDF associated with a same record stored in the table, whereby the plurality of first datafields of the plurality of UDF’s are associated with the same record and information is stored in the plurality of datafields and the information of the plurality of datafields is associated with the same record and without modification of the table” (see Fish, [0097], [0102]-[0103] and Fig. 13 a-b for the association between many user-defined fields (identifier/value pairs) with a matter number (matter record)).

As to claim 9, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a data structure having a record, a List and a list user-defined field or “List UDF”, the List UDF relatable to the record, and the List UDF comprising: an identifier of the List UDF; an identifier of the List, and a data address of the list, whereby an information stored at the data address of the List is associated with the List UDF and the information is stored or modified at the data address of the List, and the information is associated with the record and without modification of the table" (see Fish, [0085], [0087] for a list of addresses associated with a contact record; see [0052] for a list of milestone identifiers associated with a matter record; also see [0101] for storing pointer to an identifier (e.g., list) wherein pointer is interpreted as data address of the list).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571)272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2164

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung T Vy/
Primary Examiner, Art Unit 2163

Phuong-Thao Cao
Art Unit 2164
December 3, 2008